

In the Drawing:

In order to overcome the objection to the drawing, please accept the accompanying replacement drawing sheets with changes in figs. 2, 4, 5, 8a and 8b. Approval of the changes in the figures and withdrawal of the objection to the drawing is respectfully requested.

REMARKS

I. ALLOWABLE SUBJECT MATTER

The claims have been amended so that the claims that were objected to but contain allowable subject matter are now independent claims so that they can be allowed without further steps in the prosecution.

Claims 12, the part of claim 13 that depended on claim 12, the part of claim 14 that depended on claim 12 and claims 16 and 17 were found to contain allowable subject matter for the reasons summarized on pages 6 and 7 of the Office Action.

Claim 12 has been amended to include the subject matter of claims 10 and 11 (claims on which the original claim 12 depended) so that it is now an independent claim.

Claim 13 has been amended to include the subject matter of claims 10, 11, and 12 (claims on which the original claim 13 depended) so that it is now an independent claim.

Claim 14 has been amended to include the subject matter of claims 10, 11, and 12 (claims on which the original claim 14 depended) so that it is now an independent claim.

Claim 16 has been amended so that it includes the features and limitations of claims 10 and 11 (claims on which the original claim 16 depended)

so that it is now an independent claim.

Claim 17 has been amended so that it includes the features and limitations of claims 10 and 11 so that it is now an independent claim. Although claim 17 did depend on claim 16 it contains subject matter that should have also depended directly on claim 11 and has been amended accordingly.

The reasons for allowance on page 6 and 7 of the Office Action indicate that the part of claim 15 dependent on claim 12 and the part of claim 15 dependent on claim 11 are both allowable. Claim 15 has thus been amended to include the features and limitations of claims 10, 11, and 12 so that it is independent. Also a new independent claim 18 has been filed including the features and limitations of claims 15, 10, and 11 (see line 1 of page 7 of the Office Action).

For the foregoing reasons allowance of amended independent claims 12 to 17 and new claim 18 is respectfully requested.

II. PRIORITY

A certified copy of the priority document, DE 102 26 471.6, is believed to have been filed on April 6, 2006 to establish that the present claims have the benefit of the priority date, June 14, 2002. If the certified copy is not present in the file, the Examiner is requested to call the telephone number below immediately to so inform applicants' attorney.

III. INFORMATION DISCLOSURE STATEMENT

A certified English translation of DE 1 099 964 is submitted together with the present Amendment.

The filing of the English translation should obviate the need for a concise explanation and facilitate consideration of the subject matter of this reference in relation to the invention disclosed in the present claims. Please call the telephone number hereinbelow if the English translation of this DE reference is not in the file at the time this amendment is examined.

IV. CLAIM AND DRAWING OBJECTION

The claims were objected to because the drawing reference characters "5", "O", and "P" were not "disclosed within the drawings".

First the specification was amended to include these drawing reference characters by means of the simultaneous amendment, in which claims 10 to 17 were filed. See page 8 and following of the simultaneous amendment.

Second, two replacement drawing sheets showing changes made to the original drawings of the certified English translation of the PCT application accompany this amendment. These drawing sheets include the added drawing reference characters "5", "O", "P", "B", and "B' ", which are mentioned in the amended specification.

As a matter of fact our copy of the originally filed application papers shows that these modified drawings were also filed following the simultaneous amendment. However since they were not labeled "replacement sheets" the appended replacement sheets have also been filed.

Approval of the changes in the drawing figures is respectfully requested.

Furthermore withdrawal of the objection to claims 10 and 13 to 17 is respectfully requested in view of the changes on the replacement sheets.

V. AMENDED CLAIM 10 AND THE PRIOR ART

A. Changes in Claim 10

Claim 10 has been amended to further distinguish its subject matter from the cited prior art. Specifically claim 10 has been amended to state that:

(1) the embossed microstructure, which is also provided on the optically active surface, is superimposed on the embossed fine structure on the optically active surface (basis is provided by page 2, line 6, of the originally filed specification); and

(2) the fine structure (2) has a roughness that is greater than that of the microstructure (3) (see page 2, lines 16 to 17, of the originally filed specification).

B. Anticipation based on Shie, et al

Claims 10, 13/10 and 14/10 were rejected under 35 U.S.C. 102 (b) as anticipated by Shie, et al, US Published Patent Application 2001/0033726.

Shie, et al, disclose an optical element or lens with an optically active surface provided with a fine structure like that shown in figures 1a, 1b, 10a and 10b, especially as disclosed in paragraph 0054. Most of the embodiments shown in the drawing however have the fine structure on a plane surface opposite from the optically active surface.

Furthermore Shie, et al, do not disclose a microstructure superimposed on the embossed fine structure.

Especially Shie, et al, do not disclose a microstructure with a roughness that is less than the roughness of the fine structure. This is the essential feature that helps to provide the soft-focus effect described in the last paragraph of the originally filed specification, which is shown in applicants' fig. 8b. This soft-focus effect is the essential improvement due to the inventive structure.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

Shie, et al, do not disclose a microstructure superimposed on the fine structure that has a roughness that is less than that of the fine structure.

For the foregoing reasons and because of the changes in amended claim 10 withdrawal of the rejection of claim 10 under 35 U.S.C. 102 (b) as anticipated by Shie, et al, US Published Patent Application 2001/0033726, is respectfully requested.

C. Anticipation Rejection based on Pocius, et al

Claims 10, 13/10, 14/10, and 15/10 were rejected under 35 U.S.C. 102 (e) as anticipated by Pocius, et al, US Published Patent Application 2002/0141006.

Pocius, et al, do disclose an optical device with a Fresnel lens that has a fine structure, as shown in figure 2b.

First the fine structure of Pocius, et al, is not in undulating form, like the applicants' undulating form because it has discontinuities. It is in the form of a saw-tooth structure in which one side of each tooth is curved. An undulating or wave-like structure as shown in applicants' figures 2, 6 and 7 is not the same as the structure shown in Pocius's figure 2b. This difference helps the structure of Pocius perform its intended function.

Second Pocius, et al, do not disclose a microstructure superimposed on the fine structure. Third Shie, et al, do not disclose a microstructure with a roughness that is less than the roughness of the fine structure. As noted above these features of the microstructure provide the desired soft-focus effect that is the purpose of applicants' invention.

The argument on page 4 of the Office Action regarding the reflective coating is not understood because "reflective" coatings provided on optical surfaces are designed to be smoother than a fraction of a wavelength of light. Thus there will be no small reflective particles that provide a microstructure. By definition the "microstructure" is designed to scatter light to produce a soft-focus effect and hence must include surface height variations that are larger than a

wavelength of light. In contrast, in a reflective coating the surface irregularities must be less than a fraction of the wavelength of light so that the surface reflects instead of scatters.

For the foregoing reasons and because of the changes in amended claim 10 withdrawal of the rejection of amended claim 10 under 35 U.S.C. 102 (e) as anticipated by Pocius, et al, US Published Patent Application 2002/0141006, is respectfully requested.

D. Obviousness Based on a Combination of Shie, et al, and JP 10-123307

Claims 11, 13/11 and 14/11 were rejected under 35 U.S.C. 103 (a) over Shie, et al, in view of JP 10-123307.

The JP reference does not disclose or suggest the features of amended claim 10 that are lacking in Shie, et al.

Specifically both Shie, et al, and the JP reference show an optical element or line with only a single fine structure on an optically active surface or another surface. Neither prior art reference discloses a fine structure with another completely different type of microstructure superimposed on it. The microstructure of the invention has a roughness that is smaller than or less than that of the fine structure.

It is well established by many U. S. Court decisions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed

invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2nd 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141

For the foregoing reasons it is respectfully submitted that amended claim 10 should not be rejected under 35 U.S.C. 103 (a) over Shie, et al, in view of JP 10-123307.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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